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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053298
Party	Defendant Kimberly Kearney
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IN THE UNITED STATES PATEN AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Tyler Perry Studios, LLC:	:	
	:	Cancellation No. 92053298
Petitioner,	:	
	:	Registration No. 3,748,123
v.	:	
	:	Mark: WHAT WOULD JESUS DO
Kimberly Kearney	:	
	:	
Registrant,	:	

RESPONDENT'S BRIEF

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I. PRELIMINARY STATEMENT

Introduction

This Cancellation Proceeding involves the good faith registration of the mark WHAT WOULD JESUS DO in connection with entertainment services in the nature of an ongoing reality based television program. The mark at issue in this proceeding is US Registration No. 3,748,123 ("the '123 Reg."). The respondent, Kimberley Kearney ("Respondent") first used this mark in November 2007 at which time she initiated the beginning stages of her reality based television program. During the initial stage of production, Respondent *shared* her television program and title with Tyler Perry Studios ("Petitioner"). Subsequently, Respondent filed for an application to register the mark. Not many months after *sharing* this program and *soliciting* the Petitioner for financial support of this program, Petitioner filed to register this mark; consequently, eventually resulting in this cancellation proceeding.

Petitioner alleges that Respondent *never* used this mark and fraudulently obtained it. Petitioner also contends that the Respondent abandoned this mark. During this cancellation proceeding the only evidence Petitioner offered in support of cancellation of now '123 Reg., are the defaulted answers from the Request for Admissions that were deemed admitted as a result of Respondent's late response.

Burden

A. Use and Abandonment

"A petitioner always bears the burden of proof by a preponderance of the evidence in a cancellation proceeding, whether the argument for cancellation is based on abandonment, likelihood of confusion, or any other ground". see *W. Florida Seafood, Inc. v. Jet Restaurants,*

Inc., 31 F.3d 1122, 1128 (Fed. Cir. 1994). Section 45 of the Trademark Act, 15 U.S.C § 1127, describes a mark to be abandoned when:

> Its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

B. Fraud

"Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register." see *Univ. Games Corp v. 20Q.net Inc*., 87 U.S.P.Q.2d 1465 (TTAB 2008) (finding that proactive corrective action by applicant resolved doubt of intent to commit fraud thereby dismissing fraud claim) "There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive." see *In re Bose Corp*., 580 F.3d 1240, 1246 (Fed. Cir. 2009) *(*finding that Bose had not committed fraud in renewing its mark when it claimed use on all goods in the registration while knowing that it had stopped manufacturing and selling certain goods.) "Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim." *Id*.

The Standard of "Use in Commerce"

An applicant who bases their application on use in commerce under §1(a) of The Trademark Act, 15 U.S.C. §1051(a), must use that mark in commerce on or in connection with

all the goods and services listed in the application as of the filing date.* Section 45 of The Trademark Act defines "commerce" as "all commerce which may lawfully be regulated by Congress."

The Trademark Law Revision Act of 1988 amended the definition of "use in commerce" to include the phrase "bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." The legislative history of the Act clarifies that 'use in the ordinary course of trade' will vary from one industry to another. Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, *Legislative History*.

More specifically, the report of the House Judiciary Committee stated that: "While use made merely to reserve a right in a mark will not meet this standard, the Committee recognizes that 'the ordinary course of trade' varies from industry to industry". *H.R. Rep. No. 1028*, 100th Cong. 2d Sess. 15 (1988). Moreover, the report of the Senate Judiciary Committee stated that: "The committee intends that the revised definition of 'use in commerce' be interpreted flexibly so as to encompass various genuine, but less traditional, trademark uses…" *S. Rep. No. 515*, 100th Cong. 2d Sess. 44-45 (1988).

Factors to consider when determining compliance with the statutory requirement for a 'bona fide use of a mark in the ordinary course of trade' are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry. Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website. see *Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997) (finding that Bucci did use Planned Parenthoods mark in commerce by the use of his website)

II. DESCRIPTION OF THE RECORD

The evidence of record consist of evidence introduced by Petitioner, and the file histories for the '123 Reg., and Petitioner's U.S. Appl. Serial No. 77/477,214.

Petitioner's Notice of Reliance contained the following evidence:

Description:	Exhibit
A copy of Petitioner's Requests for Admission	Exh. A
Mailing receipts showing timely service to Respondent via FedEx.	Exh. B

III. STATEMENT OF THE ISSUE

Whether petitioner should be entitled to the cancellation of the mark WHAT WOULD JESUS DO in connection with entertainment services when Petitioner has failed to meet the requisite burdens of proof for fraud, abandonment, and nonuse.

IV. RECITATION OF THE FACTS

A. Respondent

Respondent is a recognized actress who has expanded her career to primarily producing in television. For over a decade she has been involved in the creative process of film production and is no novice when it comes to what it takes to be involved in and produce a reality television program. Respondent is an independent producer who has worked with UPN and CW and has worked on shows viewed on VH1, NBC, Lifetime, and WeTV. She is working diligently to expand her career, but, admittedly does not have the limitless funds granting her access to produce multi-million dollar films. Nevertheless, she is currently working in production to continue her contributions to the entertainment industry.

B. Timeline of the Registration

November 11, 2007 Respondent initiated production of WHAT WOULD JESUS DO by preparing marketing packages for the reality based television show. see '123 Reg., *file history* January 14, 2008, while still in the preproduction phase of producing the television program, Respondent filed an application to register the mark WHAT WOULD JESUS DO App. Ser. No. 77371640. see '123 Reg., *file history* Respondent applied for this mark as "use in commerce" based the work she had already begun in November 2007. see '123 Reg., *file history* January 13, 2009, notice was given that the specimen provided on January 14, 2008 was insufficient. see '123 Reg., *file history* Respondent offered a new specimen July 8, 2009. see '123 Reg., *file history* The specimen provided was a screenshot of her website, specifically the page of her site where she solicited actors, investors and the like to become involved in this television program. see '123 Reg., *file history* Cognizant of the examining attorney's recent denial of her last specimen, Respondent stated in her description of the new specimen "If necessary we will amend the date of use in commerce to July 8, 2009. Although the specimen originally provided we considered use in commerce since it was part of a marketing package used to solicit advertising/sponsors for the show, as of the original filing date." see '123 Reg., *file history* The mark was granted registration February 16, 2010. see '123 Reg., *file history*

V. ARGUMENT

A. Petitioner has Failed to Provide Evidence Sufficient to Rise to the Level of Proof Required to Prove Fraud

Petitioner alleges that Respondent fraudulently obtained '123 Reg. and fraudulently declared use in commerce of the mark WHAT WOULD JESUS DO. To prevail in this

cancellation proceeding where fraud is alleged, Petitioner must prove by way of clear and convincing evidence that Respondent knowingly made false and material representations of a fact in connection with '123 Reg. In this case, Petitioner has failed to prove, even with use of the Requests for Admissions, that Respondent, with purpose, attempted to engage in deception when requesting this mark. To the contrary, on July 8, 2009 when Respondent submitted a new specimen, it was clearly demonstrated that Respondent, with good faith, was with the understanding that her specimen was a true indication of her prior and current use in commerce. see '123 Reg., *file history* Even if the specimen was insufficient to meet use in commerce, her mere mistake would not give rise to her behavior being deemed fraudulent. "There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive." see *In re Bose Corp*.,

Furthermore, Petitioner claims that the email address info@coolexample.com somehow proves that Respondent's website was non functional. Petitioner has provided *no* evidence outside of the use of the request for admissions, to support a nexus between info@coolexample.com and the contact email on the website provided within the specimen. With Petitioner providing only the Request for Admissions as evidence, to support such a claim as fraud, the preponderance of evidence burden has not been met, let alone the more strict of clear and convincing. "Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim." Id. Evidence of an inactive email **does not** and **cannot** draw an inference to Respondent having the intent to deceive, especially when Respondent carefully explained her intention regarding her specimen on July 8, 2009. see '123 Reg., *file history*

B. Respondent's Use of the Mark as it Relates to the Entertainment Industry is Sufficient to Support Registration of The Mark Based on Use In Commerce

The mark WHAT WOULD JESUS DO is being used as the title for a reality based television show. In the entertainment production industry there are three key phases of production- pre-production, production, and post-production. During pre-production, as her website specimen suggest, Respondent was not only holding auditions but soliciting investors. The primary function of the website was to solicit participants and investors for the show- not to provide a specimen to the Trademark Office as Petitioner alleges.

Respondent made bona fide use of the mark in a way that is customary in the entertainment industry. Congress intended to allow the flexible interpretation of "use in commerce" to accommodate "genuine, but less traditional trademark uses" such as this. S. Rep. No. 515, 100th Cong. 2d Sess. 44-45 (1988). Considering factors such as (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry, it is clear that Respondent's use of the mark is in compliance with the statutory requirement for a 'bona fide use of a mark in the ordinary course of trade'. Respondent used the mark in every instance and in every dealing with potential investors and participants. The way in which Respondent used the mark is typical in the entertainment industry during the pre-production phase.

Respondent filed her application to January 14, 2008 and Petitioner claimed abandonment as early as November 12, 2010. Petitioner's evidence, the Requests for Admissions, again are insufficient to show that Respondent more likely then not discontinued use of the mark or had the intention to discontinue use. Moreover, Petitioner has not provided any evidence to suggest

that Respondent has had no bona fide use of the mark in ordinary course of trade of. Conversely, Respondent has offered that her activities, while using WHAT WOULD JESUS DO, constitute use and demonstrate her intent to continue use in the entertainment profession.

Due to the Petitioner's stature and influence within the entertainment industry, Respondent was forced to put all pre-production efforts on hold. She was forced to disclose the pending proceeding regarding her ownership of the WHAT WOULD JESUS DO mark. As she disclosed the existence of this proceeding with the Petitioner, her efforts to continue the pre-production preparations were stifled. Once this proceeding is resolved in Respondents favor, she has every intention of resuming the pre-production efforts that she was forced to put on hold. This intent is evidenced by Respondents vigorous defense of her mark.

VI. SUMMARY

Wherefore, Respondent respectfully requests the Board find that the Petitioner has failed to prove non use of the WHAT WOULD JESUS DO mark and has not proven that '123 Reg. was fraudulently obtained; thereby denying cancellation of this registration. Alternatively, Respondent respectfully requests that the Board allow Respondent to maintain priority and to amend her application to an "Intent to Use" application to allow her the opportunity to continue in the production phases of her television show.

Respectfully Submitted,

Kimberly Kearney

Dated: April 7, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of April, 2014 a true and correct copy of the foregoing document was caused to be served on the following party as indicated:

VIA FIRST CLASS MAIL

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